

**REMARKS**

Upon entry of the instant amendment, claims 1-4, 6, 7 and 17-47 will remain pending in the above-identified application and stand ready for further action on the merits.

In this Amendment, claims 4 and 6 have been amended to depend from claim 1 instead of "any one of claims 1 to 3," respectively (without any prejudice and disclaimer of the subject matter contained therein). New claims 18-47 have been added. Claims 5, 8 and 9 have been canceled, but rewritten into independent form as claims 26, 33 and 40, respectively. Claims 10-16 are cancelled but added as new claims 41-47, which depend from claim 40, respectively.

Support for new claim 18 can be found in claim 1, at page 12, line 23 to page 17, line 6 of the specification, and Figs. 1-7.

Support for new claim 19 can be found at page 12, line 23 to page 16, line 22 of the specification and Figs. 1-6.

Support for new claim 20 can be found at page 16, line 23 to page 17, line 6 of the specification, and Fig. 7.

Support for new claims 21-25 can be found in claims 2-5 and 8, respectively.

Finally, new claims 27-32 and 34-39, which depend from allowable claim 5, 8, or 9, are also added based on claims 2-4, 6, 7 and 17, as explained below.

Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

***Claim Rejections under 35 U.S.C. §§ 102 and 103***

Claims 1-2, 4, 6 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kricka US '366 (US 5,744,366).

Further, claims 3 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kricka US '366.

Applicant respectfully traverses and requests that the Examiner withdraw the rejections.

***Novelty and Nonobviousness over the Cited Reference***

The cited reference, Kricka US '366, as the Examiner alleges in the Office Action, discloses an apparatus for detecting chemotaxis of cells which comprises;

receiving well 32 (a cell-holding well having an opening for injecting cells);

target chamber 22 (a specimen-holding well having an opening for injecting a specimen);

mesoscale flow channel 20 and mesoscale filter 24 (a channel which connects said cell-holding well and specimen-holding well up with each other and has resistance to the passage of cells);

delivery apparatus 110, such as a pipette or syringe; and

removable seal 30a and sealant 30b (a means of sealing said opening(s) in one or both of said cell-holding well and said specimen-holding well) (Applicant's emphasis added; see column 11 of the reference).

However, Kricka et al. US '366 fails to disclose or suggest "*a means of transporting said liquid from said cell-holding well to said specimen-holding well by an injection or an aspiration discharge of said liquid and then stopping the transportation of said liquid after said injection or*

*said aspiration discharge of said liquid in order to control a position of each cell in said cell-holding well*" (emphasis added), which is one of features of the present invention, as recited in independent claims 1 and 18. Although the Examiner alleges that the delivery apparatus 110 corresponded to a means of transporting the liquid from the cell-holding well, the delivery apparatus 110 of Kricka US '366 merely corresponds to the cell injector 20 as described in Figs. 6-9 of the present invention, but it does not correspond to a means of transporting said liquid from said cell-holding well of the present invention, since it only applies a sample comprising the motile cell of interest (*e.g.* a sperm sample) at inlet port 16a (see lines 23-28 in column 11 of Kricka US '366).

In addition, Kricka US '366 fails to disclose or suggest an injection pipe and/or an aspiration discharge pipe are employed in order to control a position of each cell in said cell-holding well (see, *e.g.*, claim 18).

As explained above, the Kricka US '366 does not disclose or suggest all of the claimed features. Thus, the present invention is not anticipated by the cited reference. Further, a *prima facie* case of obviousness cannot be established based on Kricka US '366 alone. Likewise, there is no rationale for one skilled in the art to arrive at the claimed invention based on Kricka US '366. (Incidentally, claims 24 and 25 recite the allowable subject matter as stated in the Office Action (*i.e.*, the subject matter of previous claims 5 and 8), respectively. Thus, at least, claims 24 and 25 are allowable.)

Therefore, the present invention (independent claims 1 and 18 and dependent claims thereon) is neither anticipated by nor obvious over the Kricka US '366 reference. Applicant respectfully requests that the Examiner withdraw the rejections.

***Allowable Subject Matter***

Applicant appreciates the Examiner's courtesy in indicating that Claims 5 and 8-16 would be allowable if rewritten in independent from including all of the limitations of the base claim and any intervening claims.

Claim 5 has been rewritten in an independent format as new claim 26, while incorporating the features of claim 1. Further, new dependent claims 27-32, which depend on claim 26, correspond to claims 2-4, 6, 7 and 17, respectively.

Also, claim 8 has been rewritten in an independent format as new claim 33, while incorporating the features of claim 1. Further, new dependent claims 34-39, which depend on claim 33, correspond to claims 2-4, 6, 7 and 17, respectively.

Finally, claim 9 has been rewritten in an independent format as new claim 40, while incorporating the features of claim 1. Further, new dependent claims 41-47, which depend on claim 40, correspond to claims 10-16, respectively.

Thus, upon entry of the present amendment to the claims, at least, new claims 26-47 are allowable.

***Information Disclosure Statement (IDS)***

Applicant filed a new IDS on August 11, 2009. The Examiner is respectfully requested to consider the documents and initial the SB08 form submitted with the IDS.

### CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. L0053 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: **AUG 26 2009**

Respectfully submitted,

By Gene J. Murphy #48,501  
Gerald M. Murphy, Jr.  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant